

O-066-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2514247
BY JACK SCHITT LIMITED
TO REGISTER A SERIES OF TWO TRADE MARKS:**

**JACK
SCHITT**

Jack Schitt

**AND THE OPPOSITION THERETO
UNDER NO. 99836
BY PAUL EVANS**

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to register a series of two trade marks:**

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thereto under no. 99836
by Paul Evans**

1. On 22 April 2009, Jack Schitt Limited, which I will refer to as JS, filed an application for the above series of two trade marks. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 28 August 2009. Paul Evans filed a notice of partial opposition to the application, opposing the goods which I have underlined in the specification¹:

Tee shirt male/female, sweatshirt male/female, flannel shirt male/female, denim shirt male/female, driver jacket male/female, college jacket male/female, polo (collared) shirt male/female, shorts male/female, mens trunks (swimwear), bikini, mens briefs/slip, other underwear - male, female bra and knickers, cardigan male/female, capped sleeve shirt male/female, hoodie top male/female, trainers male/female, sandals male/female, shoes male/female, sports footwear male/female, flip flops male/female, socks male/female, football shirt male/female, rugby shirt male/female, baseball cap, peaked knitted hat, bandana, sarong, scarf, gloves male/female, mittens male/female, boots male/female, wellingtons male/female, slippers male/female.

2. The opposition is based on two grounds: section 3(3)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Mr Evans, under section 5(2)(b), relies upon his trade mark registration, as follows:

2267308 Jacques Schitte

Class 25: *Clothing, footwear, headgear.*

Section 5(2)(b) of the Act states:

"(2) A trade mark shall not be registered if because –

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Mr Evans claims that although the spelling differs, phonetically his mark is exactly the same as the application, resulting in confusion.

3. Mr Evans’ other ground of opposition is under section 3(3)(a) of the Act. This section states:

“(3) A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality, or

...”

Mr Evans’ notice of opposition says:

“The words “Jack Schitt” were my preferred choice amongst a number of possible spellings that I submitted when applying for a trade mark in 2001. The use of all of the wording variations was refused, on the grounds of offending public taste/morality. However, on appeal, use of *Jacques Schitte* was allowed.

Although the spelling differs from Jack Schitt, phonetically, *Jacques Schitte* is exactly the same and is pronounced in the same way. My understanding at the time that the marks was granted was that the less obvious spelling was sufficient to conform to public taste, while at the same time retaining linguistic and pronunciation impact.

In the time since my original application, it is still the case that many people find Jack Schitt to be more offensive than Jacques Schitte and therefore contrary to accepted principles of morality.”

Mr Evans’ opposition under this ground is, like the 5(2)(b) ground, only against the goods which I have underlined in JS’s specification.

4. JS filed a counterstatement denying both grounds. It states that Mr Evans’ mark will be construed as a French personal name, whereas its own mark is a slang term. JS requested that Mr Evans prove use of his trade mark for all the services for which it is registered. Mr Evans’ trade mark completed its registration process on 26 April 2002, more than five years prior to the publication date of the application (28 August 2009). Section 6(A) of the Trade Marks Act 1994 (“the Act”) states:

- “(1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Mr Evans' notice of opposition contains the following statement in relation to his trade mark registration in the section of the form which relates to use or non-use of the earlier mark relied upon by the opponent:

"Delayed due to funding and marketing difficulties and to illness."

5. Mr Evans filed evidence, JS did not. Both parties were advised that they had a right to a hearing and that if one was not requested a decision would be made from the papers and any written submissions received. Neither party asked for a hearing or filed written submissions in lieu of a hearing. I have borne in mind all the evidence, the contents of the notice opposition, and the counterstatement in making this decision.

Mr Evans' evidence

6. Mr Evans has filed a witness statement dated 17 July 2010. He gives details of a search report result from the Intellectual Property Office's ("IPO") Search and Advisory Service in 2001 which looked at various permutations of 'Jack Shit'. The IPO informed Mr Evans that no similar marks were found but that the Office may raise an objection to Jack Shitt on the basis of section 3(3)(a) of the Act (exhibit A) (if the marks were made the subject of a formal trade mark application). Mr Evans states that he made a formal trade mark application for Jacques Schitte in class 25 which was initially objected to under section 3(3)(a) but, following correspondence in which Mr Evans argued that it was inconsistent for the Office to allow the mark FCUK and not his mark, the Office accepted his application (which now forms the earlier right relied upon in these proceedings).

7. Mr Evans states that in the following years he invested significant time, effort and money in researching the leisure clothing sector. He lists this effort as including:

- Expense of registering a company, Pandy Products Limited and related Jacques Schitte website domain names
- Attendance at numerous training courses, seminars, marketing sessions and meetings, primarily those arranged and run by Entrepreneur Action (EA) in Cardiff. EA went into receivership in 2008, following the demise of its funding body, the Welsh Development Agency
- Attendance at marketing seminars organized by the University of Glamorgan
- Refusing an offer to purchase the mark by a third party.

Mr Evans does not give details as to the dates when these efforts occurred.

8. Mr Evans states that he received expert advice which, whilst agreeing that the mark was humorous and a unique selling point, advised that the clothing market was and extremely difficult and competitive market for a new business to enter. He states that the difficulties in starting up his new clothing brand were exacerbated by the fact that he was in full-time employment in a demanding job, as well as suffering

from a long-term medical condition (Mr Evans does not give further details). Mr Evans states that these difficulties reduced the possibility of establishing sufficient external finance “to fund the brand”. Mr Evans says:

“The result of the above is that the launch of a project and brand that I had high hopes for, and invested a lot of time and effort in, has been continually delayed with apparently little to show for my trouble. However, as my employment is due to change in the next eighteen months to semi-or fully retired, it is my intention to resume my efforts in establishing the brand and the mark.”

The remainder of Mr Evans’ statement is in the nature of submission which I will, of course, bear in mind in making this decision, but which it is not appropriate to include in this summary of factual evidence.

Decision

9. For the benefit of both parties, who are litigants-in-person, the relevant legislation is set out above. The Trade Marks Act 1994 is harmonised with EC Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks. Consequently, I must follow the judgments of the European Union courts (the Court of Justice of the European Union (CJEU)² and the General Court (GC)³) in addition to those of the High Court, the Court of Appeal of England and Wales and the Supreme Court. The decisions of the Appointed Persons (who hear appeals from the Trade Mark Registry which do not follow the court route of appeal) are not binding but are nevertheless persuasive. I must apply theirs and the courts’ reasoning to the facts of this case.

13. In addition to section 6A of the Act, section 100 states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Mr Evans’ mark had been registered for more than five years at the date on which the application was published. It is therefore subject to proof of its use, as set out in section 6A of the Act (paragraph 4 above) or proof that there are proper reasons for it not having been used in the five years prior to publication of the application. If Mr Evans is unable to satisfy the proof of use or proper reasons for non-use requirements, he will be unable to rely upon his mark in these proceedings. The relevant period for Mr Evans to prove that he has made genuine use of the trade mark in suit, or that there are proper reasons for non-use, is 29 August 2004 to 28 August 2009. The genuine use provisions in the Act (and the Directive) ensure that proprietors have five years after registration in which to commence or make use of their mark in the course of trade for the goods and services for which the mark is registered. The reason for these provisions is to reduce the potential for conflict when new applications are sought to be registered: it would be unreasonable to

² Formerly the European Court of Justice (ECJ).

³ Formerly the Court of First Instance (CFI).

refuse to register a new trade mark application in the face of a mark which is over five years old if that earlier registered mark has not been put to genuine use by its proprietor for the goods or services for which it is registered, or if there are no proper reasons for it not having been put to use in that time.

14. Proper reasons for non-use

As I have said above, Mr Evans' notice of opposition contains the following statement:

“Delayed due to funding and marketing difficulties and to illness.”

This is a statement that the mark has not been used and that the reasons are due to funding and marketing difficulties and to illness. There is some expansion of these reasons in Mr Evans' witness statement. The CJEU, in *Häupl v Lidl Stiftung & Co KG* Case C-246/05 [2007] E.T.M.R. 61, gave consideration to the significance of the word 'proper' in the phrase 'proper reasons for non-use'. It concluded that having reasons is not enough: they must be 'proper' reasons. Whether the reasons are 'proper' must be established by the tribunal which has to decide the case. The tribunal must decide the answer as to whether the reasons are 'proper' on the basis of the evidence before it. In relation to what may be regarded as 'proper reasons' (as opposed to simply 'reasons'), the Court said:

“47 It must be stated that Art.12(1) does not contain any indication of the nature and characteristics of the “proper reasons” to which it refers.

48 However, the TRIPS Agreement, to which the Community is party, also deals, in Art.19(1), with the requirement of use of the mark and the reasons which may justify its non-use. The definition of that concept given there may therefore constitute a factor in the interpretation of the similar concept of proper reasons used in the Directive.

49 Thus, under Art.19(1) of the TRIPS Agreement, circumstances arising independently of the will of the owner of the trade mark which constitute an obstacle to the use of the trade mark are to be recognised as valid reasons for non-use.

50 It is therefore necessary to determine what kind of circumstances constitute an obstacle to the use of the trade mark within the meaning of that provision. Although, quite often, circumstances arising independently of the will of the owner of the trade mark will at some time hinder the preparations for the use of that mark, the difficulties in question are difficulties which can be overcome in a good many cases.

51 In that respect, it should be noted that the eighth recital in the preamble to the Directive states that:

“ [I]n order to reduce the total number of trade marks registered ... in the Community ... it is essential to require that registered trade marks must actually be used or, if not used, be subject to

revocation.”

It appears in the light of that recital that it would be contrary to the scheme of Art.12(1) of the Directive to confer too broad a scope on the concept of proper reasons for non-use of a mark. Achievement of the objective set out in that recital would be jeopardised if any obstacle, however minimal yet nonetheless arising independently of the will of the owner of the trade mark, were sufficient to justify its non-use.

52 In particular, as correctly stated by the Advocate General in [79] of his Opinion, it does not suffice that “bureaucratic obstacles”, such as those pleaded in the main proceedings, are beyond the control the trade mark proprietor, since those obstacles must, moreover, have a direct relationship with the mark, so much so that its use depends on the successful completion of the administrative action concerned.

53 It must be pointed out, however, that the obstacle concerned need not necessarily make the use of the trade mark impossible in order to be regarded as having a sufficiently direct relationship with the trade mark, since that may also be the case where it makes its use unreasonable. If an obstacle is such as to jeopardise seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it nonetheless. Thus, for example, the proprietor of a trade mark cannot reasonably be required to sell its goods in the sales outlets of its competitors. In such cases, it does not appear reasonable to require the proprietor of a trade mark to change its corporate strategy in order to make the use of that mark nonetheless possible.

54 It follows that only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action.

55 Having regard to the foregoing considerations, the answer to the second question referred for a preliminary ruling must be that Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance.”

15. The only part of Mr Evans’ evidence which relates to reasons for non-use is the part where he states that the difficulties in starting up his new clothing brand were exacerbated by the fact that he was in full-time employment in a demanding job, as

well as suffering from a long-term medical condition. Mr Evans states that these difficulties reduced the possibility of establishing sufficient external finance “to fund the brand”. There is no suggestion that the demise of the EA and the Welsh Development Agency was a part of the lack of funding for his JACQUES SCHITTE business; in relation to these bodies, all the evidence shows is that Mr Evans attended “numerous training courses, seminars, marketing sessions and meetings” run by EA. Essentially, his explanation of lack of funding and hence lack of use boils down to three reasons:

- (i) the clothing market is an extremely difficult and competitive market for a new business to enter;
- (ii) Mr Evans was working full-time in a demanding job;
- (iii) Mr Evans was suffering from a long-term medical condition.

16. The Court, in *Haupt v Lidl Stiftung & Co KG*, ruled that “only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as “proper reasons for non-use” of that mark.” The words ‘independently of the will of the proprietor’ are important: as can be seen from the paragraphs in the judgment, the Court was concerned that the concept of ‘proper’ reasons should not be given too broad a scope. It stated that it was not acceptable to regard any obstacle, however minimal yet nonetheless arising independently of the will of the owner of the trade mark, as ‘proper reasons’ justifying non-use of a trade mark. The court observed that “quite often, circumstances arising independently of the will of the owner of the trade mark will at some time hinder the preparations for the use of that mark, the difficulties in question are difficulties which can be overcome in a good many cases.” That might be said of any business: it is surely rare for a business not to encounter marketing or funding issues, or be stalled by personal circumstances. That is the reason why trade mark owners have a five-year window following registration in which to use their mark; however, there comes a point where, rather than encouraging innovation, the lack of use begins to stifle innovation in that the unused mark sits on the register preventing others who in a more viable business situation from registering their own mark. I note that Mr Evans’ trade mark, which was registered on 26 April 2002, was still unused at the date he made his statement, 17 July 2010, over eight years after it was registered. According to his statement, he intended to resume his efforts in bringing it to market in the eighteen months following the making of his witness statement.

17. Normal business delays, such as marketing and funding problems which require strategic planning, are not ‘independent of the will of the proprietor’. Although Mr Evans did not ‘will’ for the funding problems to happen, they were not outside of his control in the way that, for example, regulatory or legislative requirements, or export restrictions might be. The test is not subjective. As the CJEU stated in *Il Ponte Finanziaria SpA v OHIM* Case C-243/06 P [2008] ETMR 13 at paragraph 102: “The concept of “proper reasons” ... refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark...”. It was Mr Evans’ choice to register a trade mark in order to enter what he describes as a competitive market whilst in full-time employment with a long-term medical condition

which he states contributed to lack of funding; it was for Mr Evans to find a way around the factors which he cites as the reasons why the mark remained unused at the date of his statement and throughout the relevant five year period. He does not go into the details of his funding or medical problems. That these were his reasons is not in doubt; that is his subjective view. However, whether there are *proper* reasons is an objective test for the tribunal to decide, under the guidance of the authorities which I have cited.

Proof of use conclusion and consequences

18. Mr Evans has not met the tests to satisfy the tribunal that he has proper reasons for non-use of his mark. The consequence of this is that Mr Evans has failed to meet the use conditions set out in section 6A(3) of the Act. In accordance with section 6A(2) of the Act, I cannot refuse JS's application on the basis of Mr Evans' earlier mark. There is, therefore, no need to address the section 5(2)(b) ground of opposition. The opposition fails on this ground, but I now need to address Mr Evans' ground of opposition under section 3(3)(a) of the Act.

Section 3(3)(a) of the Act

19. Here, the concern is whether the application for JACK SCHITT (in its stylised series format) is "contrary to public policy or to accepted principles of morality". Mr Evans' specific complaint entered in his notice of opposition is:

"The words "Jack Schitt" were my preferred choice amongst a number of possible spellings that I submitted when applying for a trade mark in 2001. The use of all of the wording variations was refused, on the grounds of offending public taste/morality. However, on appeal, use of *Jacques Schitte* was allowed.

Although the spelling differs from Jack Schitt, phonetically *Jacques Schitte* is exactly the same and is pronounced in the same way. My understanding at the time that the mark was granted was that the less obvious spelling was sufficient to conform to public taste, while at the same time retaining linguistic and pronunciation impact.

In the time since my original application, it is still the case that many people find Jack Schitt to be more offensive than Jacques Schitte and therefore contrary to accepted principles of morality."

20. Mr Evans provides no evidence in relation to this ground, beyond the Office's objection which he met with when he attempted to register various permutations of JACK SCHITT, which was his preferred spelling, in 2001. In actual fact, the official file for his registration shows that Mr Evans originally applied for a series of thirty marks, which he then reduced to four marks *prior* to the formal examination of his mark by a trade mark examiner. The marks he chose were JACQUES SCHITTE, JACQUES SCHITT, JAK SCHITTE and JAK SCHITT; as the marks were ultimately not felt to be a series of four either, Mr Evans eventually chose the mark JACQUES SCHITTE. An initial section 3(3)(a) objection was waived and the mark proceeded to registration.

21. In particular, there is no evidential support for Mr Evans' claim that "many people find Jack Schitt to be more offensive than Jacques Schitte". It is unnecessary for the tribunal to require evidence to assess a ground of opposition brought under section 3(3)(a) of the Act; in *Woodman v French Connection Ltd* [2007] E.T.M.R. 8, Richard Arnold QC, sitting as the appointed person, concluded that the registrar's hearing officers are entitled to use their own knowledge of words and moral principles which are generally accepted in our society. I consider this to be such a case. In relying upon my knowledge of moral principles, I must assess the mark's impact from an objective viewpoint, at the date it was applied for (*Ghazilian's Trade Mark Application* [2002] E.T.M.R. 57). My personal views are irrelevant⁴.

22. Simon Thorley QC, sitting as the appointed person in *Ghazilian*, referred to the exceptional nature of a case where registration should be denied to a mark. In particular, Mr Thorley cautioned that the fact that a section of the public would find the mark offensive but merely on the basis that it is *distasteful*, is not enough:

"21 Section 3(3) refers to "accepted principals of morality". In any given social group, there are certain standards of behaviour or moral principals which society requires to be observed and there are standards of conduct which are widely shared. Society requires this so as to ensure that religious, social or family values are not unreasonably undermined. Accordingly it is right that in an exceptional case where the trade mark selected contravenes these standards it should be denied registration. Since however the primary objective of the system of registration of trade marks is to protect both traders and the public and since the system does not prevent a trader using a mark but merely denies him the protection of registration, it is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough."

In contrast, section 3(3)(a) applies if the mark would:

"justifiably cause outrage or would be the subject of justifiable censure as being likely to cause outrage or would be the subject of justifiable censure as being likely to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice."

⁴ As Simon Thorley QC, sitting as the appointed person, said in *Ghazilian*: "32 Aldous J. in *Masterman* invoked the concept of right-thinking members of the public. I believe this is a helpful approach. A right-thinking member may himself or herself not be outraged but will be able, objectively, to assess whether or not the mark in question is calculated to cause the "outrage" or "censure" that I have referred to amongst a relevant section of the public. This is the function of the Hearing Officer. The matter must be approached objectively. It does not matter whether the Hearing Officer finds the mark personally unacceptable."

23. Different considerations apply according to the type of mark/problem envisaged: the wording of section 3(3)(a) refers to public policy and morality. Underlying the application of the tests set out in *Ghazilian* and *French Connection* is the basic right to freedom of expression. Mr Arnold, drawing on previous authorities he had cited in *French Connection*, stated that, in line with Article 10 of the European Convention on Human Rights:

“It follows that registration should be refused only where this is justified by a pressing social need and is proportionate to the legitimate aim pursued. Furthermore, any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus by permitting the registration...”.

Further, marks which do not proclaim an opinion or contain an incitement or are not insults are less likely to be objectionable.

24. The nature of the application is not a relative question where the qualities of both parties' marks are important: it is one of absolute protection or refusal of JS's mark based entirely on an assessment of its own intrinsic qualities, without Mr Evans' mark being a factor in the appraisal. The slang term JACK SHIT, in the context of a sentence, means 'nothing'; for example, 'I queued for hours and ended up with jack shit.' SHIT is a commonly understood word; depending on its context it is used as an earthy synonym for faeces, or something considered to be rubbish or useless. It is also used as an expression of frustration. It is regularly used in films and television programs (although not on children's programs), being more prevalent after the 9pm watershed than before it. However, the mark is not JACK SHIT: it is JACK SCHITT. The first point which immediately comes to notice on a visual inspection of the mark is that the second word is spelled SCHITT which, in combination with the forename JACK, gives the mark the appearance of a name, with the surname having a germanic feel as a result of the use of the letter 'c' between the letters 's' and 'h'. On a basic level, the word SHIT has been disguised by the additional letter 'c' and the double 't' at the end.

25. JS has referred in its counterstatement to the *French Connection* case which involved the mark FCUK; this was held, both by the registrar and on appeal to the appointed person, to be registrable as a trade mark. There is an element of disguise about FCUK, although the decision also points out that evidence played a part in establishing which way the public barometer was pointing at the time of application. I must decide this case on its own facts; having said that, it is useful to note the guidance in the Office's Examination Guidelines which refers to the acceptability of the following mark:



The guidelines refer to KRAP as 'fairly mild bad language'. KRAP is a disguised version of CRAP, which is used in identical ways to the meanings I have identified above for SHIT.

26. In relation to FCUK, there is an obvious difference between the potential, visually, to interpret or approximate the mark to the well-known expletive, and its verbal pronunciation, which would have to be performed by enunciating each letter separately. In the present case, the opposite is true: aurally, the mark sounds identical to JACK SHIT; visually, it looks like a full name. I note that the relevant goods in the FCUK case were clothing, just as in the present case. Clothing will be seen on the wearer by the public, including children and the elderly; a trade mark may notionally be used in the neck label or emblazoned across the front of a garment (such as a t-shirt or cap). The mark is more likely to be encountered visually than it is aurally. If a mark has the potential to be offensive aurally rather than visually, the prospect of causing offence will be less if its primary mode of encounter is visual rather than aural because the visual impression will have more significance. This is germane to my assessment of JS's mark. Further, the (visual) appearance of JS's mark as a personal name is reinforced by the presentation of the second mark in the series, which looks like a signature⁵.

27. At this point, I remind myself of the tests set out in *Ghazilian*: that "mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough": to be denied registration the mark has to "justifiably cause outrage or [would] be the subject of justifiable censure as being likely to cause outrage or [would] be the subject of justifiable censure as being likely to undermine current religious, family or social values". As a version of JACK SHIT, JACK SCHITT is no worse than a crude, 'laddish' cultural synonym for 'nothing'. It is not an insult (directed at an individual) or an incitement and is not an obvious opinion. It looks like a name, although it is not a complete disguise, but is instead an adaptation of JACK SHIT in which the word-play will be apparent. As such, applying the relevant caselaw (which has for the most part been issued since Mr Evans applied for his trade mark) I consider that, at the date JS's mark was applied for, it fell squarely in the 'mere distaste' category, rather than the 'outrage/censure' category referred to in *Ghazilian*. Even if I had some doubt about this, "any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus by permitting the registration" (*French*

⁵ Beyond this observation, nothing turns upon the application's appropriateness as a series of marks.

Connection, quoted above). The section 3(3)(a) ground fails.

28. As both grounds of opposition have failed, the application should proceed to registration for all the goods in the specification.

Costs

29. JS has been successful and is entitled to an award of costs as per the scale of costs published on the Intellectual Property Office's website in Tribunal Practice Notice 6/2008⁶.

Considering the notice of opposition and preparing a counterstatement	£100
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Considering Mr Evans' evidence (JS did not comment or file its own evidence)	£200
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Total:	£300
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30. I order Paul Evans to pay to Jack Schitt Limited the sum of £300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23 day of February 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁶ It is the registrar's practice to award costs to litigants-in-person at half the rate that he awards them where a party has had legal representation.